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DATE MAILED: 02/15/2005

APPLICATION NO.	FILIN	IG DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.		
10/766,260	01/2	27/2004	Johann Engelhardt	5005.1019DIV	3405		
23280	7590	02/15/2005		EXAM	EXAMINER		
	N, DAVIDS	ROBINSON	ROBINSON, MARK A				
485 SEVEN NEW YORI		E, 14TH FLOOR 8	ART UNIT	PAPER NUMBER			
	•			2872			

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary ## Disposition of Claim(s) ## Explication is objected to by the Examiner. ## Application Papers ## Claim(s) ## Explication is objected to by the Examiner. ## Explication Papers ## Expli			Applica	tion No.	Applicant(s)				
## Mark A. Robinson 2872 ## The MAILING DATE of this communication appears on the cover sheet with the correspondence address ## Period for Reply A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(s) FROM THE MAILING DATE OF THIS COMMUNICATION. ## Extensions of time may be available under the provisions of 3 CFR 1.136(a). In no event, however, may a reply be limely filed after SIX (6) MONTH'S from the mailing date of this communication. ## If the period for reply specified above, the maniform station period will apply and will applie by the limely filed after SIX (6) MONTH'S from the mailing date of this communication. ## If the period for reply specified above, the maniform station period will apply and will applie by the filed after SIX (6) MONTH'S from the mailing date of this communication will apply and will applie by the filed may reduce any searned patent term adjustment. See 37 CFR 1.704(b). ### Status ### This action is FiNAL. ### This action is a polication is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11, 453 O.G. 213. ### Disposition of Claims ### This action is FiNAL. ### This action is FiNAL is say and the application. ### This action is final file is say and the application. ### This action is final file is say and the application. ### This action is final file is say and the application. ### This action is final file is say and the application. ### This action is final file is say and the application is one-final. ### This action is final file is say and the application. ### This action is final file is say and the application. ### This action is final file is say and the application. ### This action is final file is say and the application. ### This action is final file is say and t	Office Action Summary		10/766	260	ENGELHARDT ET AL.				
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Attachment(s) 1) Notice of References Cited (PTO-892) 2) Notice of Draftsperson's Patent Drawing Review (PTO-948) 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date 4) Interview Summary (PTO-413) Paper No(s)/Mail Date 5) Notice of Informal Patent Application (PTO-152) Paper No(s)/Mail Date	1) Notice of Ref 2) Notice of Dra 3) Information D	oftsperson's Patent Drawing Review (Disclosure Statement(s) (PTO-1449 o		Paper No(s)/Mail D 5) Notice of Informal	ate	O-152)			

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DETAILED ACTION

Election/Restrictions

1. Applicant's election without traverse of the species shown in figs. 6 and 7 in the reply filed on 12/22/04 is acknowledged. Claims 1-15 were deemed to read on the elected species and will be examined as follows. Claim 16 is withdrawn from consideration as being drawn to non-elected subject matter.

Claim Rejections - 35 USC § 103

- 2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:
 - (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.
- 3. Claims 1-10 and 12-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Xiao (US 5537247) in view of Kishi (US 6437913).

Xiao shows a scanning microscope including a light source(20), a first detector(21) for descan detection of specimen light, an objective(34) in both the illumination and

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detection beam paths, a coupling-out element(41) in the illumination and detection paths, a fiber(26) for transporting light coming from the coupling-out element to the detector, and a fluorescent light illuminator (see fig. 6) with excitation(44) and detection(45) filters.

Xiao does not teach the coupling-out element to be insertable into or removable from the beam path via a turret or that this element includes the excitation and detection filters. However, a turret-based coupling-out element is shown by Kishi. Note coupling-out turret(121) with beam splitter(10), excitation(9) and detection(11) filters and guidance and/or banking elements (those elements which enable positioning or alignment of each filter or mirror). It would have been obvious to the ordinarily skilled artisan at the time of invention to include the insertable/removable coupling-out element of Kishi in Xiao's microscope in order to enable different types of specimen imaging and/or different types of specimen illumination.

4. Claims 9 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Xiao (US 5537247) in view of Takeuchi (US 6337767).

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Xiao discloses the features of claims 9 and 11 as discussed above, but does not show the coupling-out element to be insertable/removable from the beam path via a sliding carriage. However, such is shown by Takeuchi (note fig. 3). It would have been obvious to the ordinarily skilled artisan at the time of invention to use the sliding carriage of Takeuchi in Xiao's microscope in order to enable different types of specimen imaging and/or different types of specimen illumination.

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The patents to Norton, Schoeppe, Carver, and Iwasaki all show various arrangements to microscopes.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark Robinson whose telephone number is (571) 272-2319.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Drew Dunn, can be reached at (571) 272-2312. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MR

2/10/05

MARK A. ROBINSON PRIMARY EXAMINER